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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/799,084	03/12/2004	Greg Siwak	10759-00048	8523

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EXAMINER

REYNOLDS, STEVEN ALAN

ART UNIT

PAPER NUMBER

3728

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DELIVERY MODE

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/799,084

Applicant(s)

SIWAK ET AL.

Examiner

Steven Reynolds

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 32-56 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 32-56 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/18/2007 has been entered.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 32-36, 38 and 39 are rejected under 35 U.S.C. 102(b) as being anticipated by Hartman (US 3,369,660). Hartman discloses a product package comprising a product (shoes 15) being offered for sale to a purchasing consumer; a non-rigid body (plastic and cardboard is considered non-rigid as it can be bent and

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deformed) containing the product, the body comprising a generally flat base (20) and upstanding side walls defining a generally rectangular, single compartment cavity above the base and extending between the upstanding side walls; a cover (19) configured to close said cavity, the cover extending in a generally flat and parallel relation to the base when the cover is closed; and a closure member (37 and 38) fastening said cover to said base, the closure member being movable (tab 37 is inserted and removed from slit 38) relative to the cover and to the base between open and closed positions; the upstanding side walls comprise a first pair of generally flat and parallel side walls extending from opposing side edges of the base, and a second pair of generally flat and parallel side walls interconnecting the first pair of side walls; the package has the size and shape of a lunchbox (lunch boxes can come in many different sizes); the product comprises footwear, the first pair of side walls and second pair of side walls being spaced apart from one another for a distance sufficient to contain a single pair of footwear therebetween, and the footwear substantially filling the cavity when placed therein; a handle (16) attached to one of the upstanding side walls; said closure member is located at or near a top edge of the sidewalls; and the cover is integrally formed with one of the side walls, the cover being folded over the base when closed.

4. Claims 32-34, 36-48 and 56 are rejected under 35 U.S.C. 102(e) as being anticipated by Johnson et al. (US 2005/0045521). Johnson discloses a product package comprising a product (pointer 28) being offered for sale to a purchasing consumer; a non-rigid body containing the product, the body comprising a generally flat base (12)

and upstanding side walls (14) defining a generally rectangular, single compartment cavity above the base and extending between the upstanding side walls; a cover (18) configured to close said cavity, the cover extending in a generally flat and parallel relation to the base when the cover is closed; and a closure member (zipper) fastening said cover to said base, the closure member being movable relative to the cover and to the base between open and closed positions; the upstanding side walls comprise a first pair of generally flat and parallel side walls extending from opposing side edges of the base, and a second pair of generally flat and parallel side walls interconnecting the first pair of side walls; the package has the size and shape of a lunchbox; a handle attached to one of the upstanding side walls (See paragraph 3, lines 4-8); said closure member comprises a zipper mechanism securing the cover to the side walls on three surfaces of the side walls; said closure member is located at or near a top edge of the sidewalls; the cover is integrally formed with one of the side walls, the cover being folded over the base when closed; and the compartment, more specifically the base is expandable to enlarge the single compartment (soft-sided coolers are vertically collapsible); and the body is insulated to maintain the temperature of an item in the compartment.

Regarding claim 42, Johnson discloses a package capable of holding footwear comprising a support surface; a plurality of soft side walls extending from said support surface (12) and defining a cavity capable of holding a single pair of footwear being offered for sale above said support surface, wherein at least one of said side walls comprises a flap folded over the remaining side walls to define a cover over said cavity;

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and a zipper selectively coupling and uncoupling said flap and said remaining side walls to pack and unpack the footwear for sale in said cavity.

Regarding the intended use of the claimed invention "a cavity for holding a single pair of footwear", it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. If the prior art structure is capable of performing the intended use, then it meets the claim. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Regarding claims 43-48, Johnson discloses the cavity defines a single compartment dimensioned to be capable of accommodating a single pair of footwear with the single pair of footwear substantially filling the cavity; the single compartment is expandable to provide additional storage capacity of the cavity; a carrying handle attached to one of the side walls; the upstanding side walls comprises a first pair of generally flat and parallel side walls extending from opposing side edges of the base, and a second pair of generally flat and parallel side walls interconnecting the first pair of side walls; the package has the size and shape of a lunchbox; and said zipper mechanism is located at or near a top edge of said side walls.

5. Claims 42, 46-48 and 50 are rejected under 35 U.S.C. 102(e) as being anticipated by Leung (US 6,726,019). Leung discloses a package comprising: a pair of footwear (shoes 34) being offered for sale at a point of purchase; a support surface (18); a plurality of soft (vinyl is considered soft as it can be easily deformed) side walls

(14) extending from said support surface and defining a cavity for holding a single pair of footwear being offered for sale above said support surface, wherein at least one of said side walls comprises a flap (16) folded over the remaining side walls to define a cover over said cavity; and a zipper (20) selectively coupling and uncoupling said flap and said remaining side walls to pack and unpack the footwear for sale in said cavity; the upstanding side walls comprises a first pair of generally flat and parallel side walls extending from opposing side edges of the base, and a second pair of generally flat and parallel side walls interconnecting the first pair of side wall; the package has the size and shape of a lunchbox; and said zipper mechanism is located at or near a top edge of said side walls.

6. Claims 42-49 are rejected under 35 U.S.C. 102(b) as being anticipated by Davis (US 4,334,601). Davis discloses a package capable of holding footwear comprising a support surface; a plurality of soft side walls extending from said support surface and defining a cavity capable of holding a single pair of footwear being offered for sale above said support surface, wherein at least one of said side walls comprises a flap (BT) folded over the remaining side walls to define a cover over said cavity; and a zipper (32) selectively coupling and uncoupling said flap and said remaining side walls to pack and unpack the footwear for sale in said cavity.

Regarding the intended use of the claimed invention "a cavity for holding a single pair of footwear", it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed

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apparatus from a prior art apparatus satisfying the claimed structural limitations. If the prior art structure is capable of performing the intended use, then it meets the claim. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Regarding claims 43-49, Davis discloses the cavity defines a single compartment (B) capable of accommodating a single pair of footwear with the single pair of footwear substantially filling the cavity; the single compartment is expandable to provide additional storage capacity of the cavity; a carrying handle (16A) attached to one of the side walls; the upstanding side walls comprises a first pair of generally flat and parallel side walls extending from opposing side edges of the base, and a second pair of generally flat and parallel side walls interconnecting the first pair of side walls; the package has the size and shape of a lunchbox (lunch boxes are known to come in many sizes); said zipper mechanism is located at or near a top edge of said side walls; and said footwear package is convertible into a duffel bag.

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:



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1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 32-41 and 50-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davis (US 4,334,601) in view of Official Notice. As described above in claims 42-49, Davis discloses the claimed invention except for the specific content of the package. Official Notice is taken, that it is old and conventional to include sports equipment, including shoes (cleats) in a sports equipment bag at a point of purchase. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made in view of the Official Notice to have provided the package of Davis with sporting equipment, such as shoes in order to sell the equipment and the equipment bag at the same time.

Further regarding claims 55 and 56, the structure of the package itself is inherently insulation between the articles and the environment.

### ***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Schidlowski et al. (US 3,942,707), Pfeifer et al. (US 2,883,041), Coppedge et al. (US 6,644,472) and MacKinnon (US 2003/0029770).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Reynolds whose telephone number is (571)272-9959. The examiner can normally be reached on Monday-Friday 9:00am - 4:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571)272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SR

8/9/07



Mickey Yu  
Supervisory Patent Examiner  
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